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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/582,345

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UEMORI3

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EXAMINER

CALAMITA, HEATHER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,345	Applicant(s) UEMORI ET AL.	
	Examiner HEATHER G. CALAMITA	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/12/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of Application, Amendments, and/or Claims

1. Claims 1-10 are pending. Claims 6, 7 and 9 are withdrawn as being directed to non-elected subject matter. Claims 1-5 and 8 are under examination. All arguments have been fully considered and thoroughly reviewed, but are deemed not persuasive for the reasons that follow. Any objections and rejections not reiterated below are hereby withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Cleuziat et al. (USPN 5,824,517).

With regard to claim 1, Cleuziat et al. teach a method for amplifying a nucleic acid, the method comprising the steps of:

A) preparing a reaction mixture

(b) a nucleic acid as a template a deoxyribonucleotide triphosphate, a DNA polymerase having a strand displacement activity, at least two chimeric oligonucleotide primers and an RNase H, wherein one of the chimeric oligonucleotide primers serves as a ladder-forming oligonucleotide primer (see col. 6 line 41 to col. 7 line 31, where, two chimeric primer, RNase H, a DNA polymerase having strand displacement activity is used. Additionally, one of the chimeric primers serves as a ladder-forming

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primer as this primer meets the requirements outlined in the instant specification in paragraphs 0054 and 0055. See also col. 11 lines 10 to col. 12 line 66).

wherein each chimeric oligonucleotide primer contains a ribonucleotide as well as at least one selected from the group consisting of a deoxyribonucleotide and a nucleotide analog, and the ribonucleotide is positioned at the 3' terminus or on the 3'terminal side of the primer (see the abstract and col. 6 lines 7-9)

wherein the chimeric oligonucleotide primers comprise at least a first chimeric oligonucleotide primer which is complementary to a nucleotide sequence of the nucleic acid as a template and a second chimeric oligonucleotide primer which is homologous to a nucleotide sequence of the nucleic acid as a template, (see col. 6 line 41 to col. 7 line 31 and also col. 11 lines 10 to col. 12 line 66)

wherein the ladder-forming oligonucleotide primer has a sequence complementary to a region of the nucleic acid as a template that is complementary to the first chimeric oligonucleotide primer and/or a nucleotide sequence 3' to said region and has on its 5' side, a sequence complementary to a nucleotide sequence on the 5' side of the second chimeric oligonucleotide primer which is homologous to the nucleic acid template; a nucleotide sequence of the nucleic acid as a template corresponding to a region 5' to the 5' terminus of the portion homologous to the second chimeric oligonucleotide primer; or both (see col. 6 lines 41- col. 7 line 31 and also col. 11 lines 10 to col. 12 line 66)

(B) incubating the reaction mixture for a sufficient time to generate a ladder-like amplification product under constant-temperature conditions under which specific annealing of the primer to the nucleic acids as a template, a reaction of synthesizing an extended strand and a strand displacement reaction by the DNA polymerase, as well as a reaction of cleaving an extended strand by RNase H take place (see col. 6 lines 41- col. 7 line 31 and also col. 11 lines 10 to col. 12 line 66, where ladder-like products are generated necessarily because of the presence of the ladder-forming primer, as defined in the instant specification)

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With regard to claim 2, Cleuziat et al. teach the nucleic acid template is RNA and the nucleic acid is treated beforehand with a dntp, a DNA polymerase having a reverse transcription activity and at least one ladder-forming oligonucleotide primer to convert the nucleic acid into a reverse transcription product (see col. 6, lines 1-40, where the template can be RNA or DNA).

With regard to claim 3, Cleuziat et al. teach wherein the reaction mixture in step (A) further contains a DNA polymerase having reverse transcription activity (see col. 6 lines 31-37)

With regard to claim 4, Cleuziat et al. teach the nucleic acid template is an mRNA (see col. 8 lines 47-56, where total nucleic acid isolation is discussed and total RNA necessarily includes mRNA)

With regard to claim 5, Cleuziat et al. teach a single DNA polymerase having reverse transcription activity and strand displacement activity (see col. 6 lines 31-37)

With regard to claim 8, Cleuziat et al. teach a method for amplifying a nucleic acid, the method comprising the steps of:

(a) amplifying a target nucleic acid according to the method for amplifying a nucleic acid defined by claim 1 and (see citations for rejected claim 1, as they all apply here)

(b) detecting the amplified target nucleic acid (see col. 8 line 45, where Cleuziat disclose detecting target nucleic acids).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cleuziat et al. (USPN 5,824,517) in view of Abstract number XP-002307629 (2000).

The teachings of Cleuziat et al. are described above.

Cleuziat et al. do not teach a chimeric primer having a ribonucleotide at the 3' terminus of the primer.

With regard to claim 10, Abstract XP-002307629 teaches chimeric oligonucleotide primers which contain a ribonucleotide at the 3' terminus of the primer [see p. 1 second full paragraph under 2)].

It would have been prima facie obvious to place the ribonucleotide at the 3' terminus of a chimeric primer as disclosed by Abstract XP-002307629 and use the primer in a DNA amplification method as disclosed by Cleuziat et al. because Abstract XP-002307629 disclose the successful use of chimeric primers with a ribonucleotide at the 3' terminus in a DNA amplification method. An ordinary practitioner would have been motivated to place the ribonucleotide at the 3' terminus of a chimeric primer as disclosed by Abstract XP-002307629 and use the primer in a DNA amplification method as disclosed by Cleuziat et al. in order to amplify DNA using chimeric primers containing ribonucleotides.

Response to Arguments

4. Applicants' arguments filed January 5, 2009, have been fully considered but they are not persuasive.

Applicants' argue the primer used in Cleuziat has an RNA portion at the 5' terminal side of the DNA and a DNA portion at the 3' terminal side. This argument is not persuasive because Cleuziat teach a chimeric primer that includes in the 5' to 3' direction an RNA-type segment which hybridizes with a 3' terminal segment of the target. Applicant's claims only require that the ribonucleotide is positioned on the 3' terminal side of the primer. The primer of Cleuziat has RNA in the 5' to 3' direction and as such the RNA is on the 3' terminal side of the primer. Also Cleuziat teaches that there is a DNA type segment

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capable of hybridizing with the segment adjacent to the 3' terminal segment of the target, this does not indicate the DNA type segment is at the 3' terminal end of the primer. The rejections are therefore maintained.

Summary

5. No claims were allowed.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather G. Calamita whose telephone number is 571.272.2876 and whose e-mail address is heather.calamita@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route. The examiner can normally be reached on Monday through Thursday, 7:00 AM to 5:30 PM.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at 571.272.0782.

Papers related to this application may be faxed to Group 1637 via the PTO Fax Center using the fax number 571.273.8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 571.272.0547.

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

/GARY BENZION/

Supervisory Patent Examiner, Art Unit 1637